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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,208	11/03/2001	Mark A. Spencer	LNS0001	2162
7590	01/14/2005		EXAMINER	
Curtis W. Dodd 2803 Bentley Street Huntsville, AL 35801			NGUYEN, THANH (TAMMY) T	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/008,208	SPENCER, MARK A.	
	Examiner Tammy T Nguyen	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 November 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 19-21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 and 16-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-21 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date July 3, 2002.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_



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***Detailed Office Action***

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, 16, 17, and 18, drawn to a method of providing a telephone connection to a phone number over a network from a client connected to the network, classified in **class 709, subclass 203**.
  - II. Claims 13-15 and 19-21, drawn to a system for providing disputeless billing for network phone service to a client over a network including having a central server and a provider, classified in **class 709, subclass 218**.
  
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of providing a telephone connection to a phone number over a network from a client connected to the network, classified in a *different Class/ Subclass*. And invention II has separate utility such as a system for providing disputeless billing for network phone service to a client over a network including having a central server and a provider, classified in a *different Class/Subclass*. See MPEP § 806.05(d).

3. The inventions are distinct, each from the other because of the following reasons:

(a) These inventions have acquired a separate status in the art as shown by their different classifications.

(b) The search required for each Group is different and not co-extensive for examination purposes.

For example, the searches for the two inventions would not be co-extensive because these Groups would require different searches on PTO's classification class and subclass as following:

The Group I search (claims 1-12, 16-18) would require use of search **Class 709, subclass 203** (not require for invention II).

The Group II search (claims 13-15, 19-21) would require use of search **Class 709, subclass 218** (not require for the invention I).

For the reasons given above restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

5. During a telephone conversation with Applicants' Representative, Curtis Dodd (Reg. No. 37,314), on December 20, 2004 a provisional election was selected group I (claims 1-12, 16-18).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more

of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. This action is in response to the application **10/008208** filed. **November 3, 2001.**
8. Claims **1-12, 16-18** are represented for examination.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3-5, 16, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Miloslavsky et al. (USPN 6,581,105 – Date of Patent: June 17, 2003, herein referred to as “Miloslavsky”).

11. As to claim 1, Miloslavsky teaches the invention as claimed, including a method of providing a telephone connection to a phone number over a network from a client connected

to the network, the method comprising the steps of: sending the phone number and an information request from the client to a central server (see col.11, line 38 to col.12, line 35); providing from the central server to the client, addresses of one or more providers and the requested information (Fig.5) (see col.12, lines 30-45); selecting in accordance with a selection criteria the best provider from the one or more providers (Fig.12)(col.21, line 13-32); and connecting a network voice path to the phone number through the address of the best provider (Fig.13) (see col.11, line 60 to col.12, line 5, col. 20, lines 28-38, col.21, lines 28-46).

12. As to claim 3, Miloslavsky teaches the invention as claimed, further comprising the step of pinging each of the addresses by the client after the providing step (see col.15, lines 1-57).

13. As to claim 4, Miloslavsky teaches the invention as claimed, wherein a failure in the connecting step is followed by the step of selecting the next best provider and connecting to the next best provider (see col.21, lines 28-46).

14. As to claim 5, Miloslavsky teaches the invention as claimed, where the network is the Internet (Fig.5, Internet 1106).

15. As to claim 16, Miloslavsky teaches the invention as claimed, including a system for providing a voice connection over a network, the system comprising: one or more providers connected to the network, the providers having provider information related to the voice connection (Fig.5) (see col.9, line 65 to col.10, line 64); a central server connected to the network and having a table for storing and updating provider information, the central server having server logic for filtering provider information (Fig.5, central server 1102 connect to Internet 1106) (see col.11, line 60 to col.12, line 50); and a client adapted to initiate a voice call

to a phone number and to request and to receive filtered provider information from the central server (Fig.13) (see col.11, line 60 to col.12, line 5, col. 20, lines 28-38, col.21, lines 28-46), the client having client logic for determining the best provider and for establishing a voice connection through the best provider to the phone number (see col.15, lines 1-38, col.21, lines 5-21).

16. As to claim 17, Miloslavsky teaches the invention as claimed, including a method of providing distributed phone service over the Internet, the method comprising the steps of: forwarding a user phone number to a user provider (see col.26, lines 8-24); verifying that the user phone number is authorized for the distributed phone service and retrieving the forwarding number (see col.39, lines 25-46); contacting, by the user provider, a central server having a list of one or more providers willing to deliver a connection to the forwarding number (see col.26, lines 1-24, col.37, line 64 to col.38, line 31); and selecting a best provider from the one or more providers and establishing a connection via the best provider (see col.21, lines 5-46).

17. As to claim 18, Miloslavsky teaches the invention as claimed, comprising the additional step of: billing the user for the call after the call has ended (see col.10, lines 19-63, and col.11, line 60 to col.12, line 51).

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2144

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2, and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miloslavsky et al., (hereinafter Miloslavsky) U.S. Patent No. 6,581,105 in view of Shaw et al., (hereinafter Shaw) U.S. Patent No. 5,870,553.

20. As to claims 2, 7, Miloslavsky does not explicitly teach selection criteria is based on latency and unit of time cost. However, Shaw teaches unit time cost (see col.1, lines 26-64, col.4, line 26 to col.5, line 41). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Miloslavsky into the computer system of Shaw to unit time cost because it would have provided a cost reduce computer system and reduced latency characteristics.

21. As to claim 6, Miloslavsky teaches the invention as claimed, including an apparatus for providing a voice connection over a network from a client site, the apparatus comprising: a data communication device at a client site for providing full duplex data transfers to the network the data communication device adapted to request information from other devices on the network (Fig.5) (client 1104 connect to Internet 1106); a central server coupled to the network and having logic for sending requested provider information related to one or more providers to the data communication device where provider information and an address for each provider (Fig.5) (Central Server connect to provider site 1108); and selection logic within the client to determine the best provider (Fig.13) (see col.21, lines 28-46). But Miloslavsky does not explicitly teach unit cost. However, Shaw teaches unit cost (see col.1, lines 26-64, col.4, line 26

to col.5, line 41). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Miloslavsky into the computer system of Shaw to unit of time cost because it would have provided a cost reduce computer system and reduced latency characteristics.

22. As to claim 8, Miloslavsky teaches the invention as claimed, wherein the network is the Internet (Fig.5, Internet 1106).

23. As to claim 9, Miloslavsky teaches the invention as claimed, wherein the central server has a provider table for storing information about providers (see col.16, line 52 to col.17, line 57, col.21, lines 28-46).

24. As to claim 10, Miloslavsky teaches the invention as claimed, wherein the provider table may be updated by each of the one or more providers (see col.16, line 52 to col.17, line 57, col.21, lines 28-46).

25. As to claim 11, Miloslavsky teaches the invention as claimed, including a method of providing a voice connection over the Internet from a user site having a communication device, the method comprising the steps of: entering a phone number in the communication device (Fig.5 1128 connect PSTN 1164); sending the phone number and a provider information request from the communication device to a central server (see col.11, line 38 to col.12, line 35); providing from the central server to the communication device a list of one or more providers satisfying a criteria (see col.24, lines 10-65); selecting the best provider from the one or more providers where the dominant selection factor with a selection algorithm a desired provider from the one or more providers (fig.5, provider site 1108) (see col.12, lines 5-45); and connecting an Internet voice path to the phone number through the desired provider (Fig.13) (see col.11, line 60

to col.12, line 5, col. 20, lines 28-38, col.21, lines 28-46). But Miloslavsky does not explicitly teach pricing; unit cost, pinging each of the one or more providers to determine latency. However, Shaw teaches pricing information, unit cost and determining latency (see col.1, lines 26-64, col.4, line 26 to col.5, line 41). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Miloslavsky into the computer system of Shaw to determine latency, unit cost and pricing information because it would have provided a cost reduce computer system and reduced latency characteristics.

26. As to claim 12, Miloslavsky teaches the invention as claimed, including a system for providing a voice connection over the Internet to one or more clients, the apparatus comprising: a central server coupled to a network, the central server having a table of provider information where the table includes phone number patterns, the central server further having a communication protocol for responding to inquiries from the one or more clients (fig.5) (see col.5-51); and client logic for requesting information from the central server and for selecting a best provider (see col.21, lines 5-45). But Miloslavsky does not explicitly teach pricing information. However, Shaw teaches pricing information (see col.1, lines 26-64, col.4, line 26 to col.5, line 41). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Miloslavsky into the computer system of Shaw includes pricing information because it would have provided a cost reduce computer system and reduced latency characteristics.

***Conclusion***

27. Any inquiries concerning this communication or earlier communications from the examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at **(571) 272-3929**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding this instant application, please send it to **(703) 872-9306**. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Bill Cuchlinski, may be reached at **(571) 272-3905**.

TTN  
January 5, 2005



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